

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Forecast Trading Corporation

Serial No. 75/184,786

Julie A. Greenberg of Gifford, Krass, Groh, Sprinkle,
Patmore, Anderson & Citkowski, P.C. for Forecast Trading
Corporation.

Jeri J. Fickes, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Hohein, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Forecast Trading
Corporation to register the mark ORIGINAL ENGINE MANAGEMENT
for "mail order catalog services featuring automobile
parts, namely, engine control components" in International
Class 35.¹

¹ Application Serial No. 75/184,786, filed October 21, 1996,
based on applicant's assertion of a bona fide intent to use the
mark in commerce.

The Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the mark ORIGINAL ENGINE MANAGEMENT, if used in connection with the services of the applicant, is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney contends that applicant's combining of the laudatory term "original" with the descriptive words "engine management" does not create a unitary mark with a separate non-descriptive meaning; that "engine management" is a technical term used to describe a particular electronic system for automobiles that controls the engine's ignition and fuel supply; that engine management products are synonymous with engine control components; and that "engine management" identifies not only the system, but also the automobile parts used within or integral to such a system. The Examining Attorney concludes that the mark ORIGINAL ENGINE MANAGEMENT "identifies the field of applicant's mail order services inasmuch as it describes the category of items marketed through the catalog services" (brief, p. 2).

In support of her position the Examining Attorney submitted a photocopy of the PTO printout of another application owned by applicant (application Serial No. 75/230,046²) which lists the goods therein as "automotive engine management components, namely, ignition coils, ignition modules, distributor caps, distributor rotors"; and several excerpted stories and one full story reprinted from the Nexis database to establish that "engine management" is a technical term used to describe a particular electronic system for automobiles that controls the engine's ignition and fuel supply, and the parts thereof.³

Applicant argues that its services are "for locating and distributing specific automobile parts, which information is collected in the form of catalogs" (brief, p. 2); that the words "engine management" do not in any way

² This application subsequently issued on July 28, 1998 as Reg. No. 2,177,530 for the mark OEM ORIGINAL ENGINE MANAGEMENT and design. The registration includes a disclaimer of the words "original engine management."

³ We note that a few of the excerpted Nexis stories are from foreign publications and/or from newswire services. These excerpts are of minimal evidentiary value. This is because newswire stories cannot be presumed to have appeared in any publication available to the consuming public, and we have no evidence concerning the possible circulation in the United States of the foreign publications from which to infer the possible impact on the perceptions of the relevant public in this country. See *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992); and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986).

describe the goods applicant provides which are catalogs; that the mark ORIGINAL ENGINE MANAGEMENT "is more likely to suggest that services relating to engine maintenance are provided rather than catalogs providing information pertaining to the location and distribution of particular auto parts" (brief, p. 3); that the mark does not provide any information to consumers that applicant's services are catalogs which collect and compile information about certain auto parts; that the mark does not immediately convey information to prospective purchasers about applicant's services, but instead requires imagination and thought to make a connection between the mark ORIGINAL ENGINE MANAGEMENT and applicant's mail order catalog services featuring automobile parts, namely engine control components; and that any doubt as to the question of whether a mark is merely descriptive should be resolved in applicant's favor.

A mark is merely descriptive if, as used on or in connection with the goods or services in question, it immediately conveys information about an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services in connection with which it is used, or intended to be used.

See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). By contrast, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

Further, the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on or in relation to the goods or services, it immediately conveys information about their nature. See *In re Abcor Development Corp.*, *supra*; *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The term "original" is defined in Webster's Ninth New Collegiate Dictionary (1990) as, *inter alia*, "not secondary, derivative or imitative," and "being the first instance or source from which a copy, reproduction or

translation is or can be made"; and in The American College Dictionary (1970) as, inter alia, "a primary form or type from which varieties are derived," and "an original work, writing, or the like, as opposed to any copy or imitation."⁴ Thus, in relation to applicant's services, the term "original" would be understood by consumers as indicating that applicant's mail order services feature "authentic" or "genuine" engine control parts. Such common and laudatory terms must remain available for the trade and competitive use to which they are so relentlessly put. See *In re Ervin*, 1 USPQ2d 1665 (TTAB 1986) (THE "ORIGINAL" shown in stylized lettering held merely descriptive of game equipment, namely a scorer for playing euchre); and *General Foods Corporation v. Ralston Purina Company*, 220 USPQ 990 (TTAB 1984) (ORIGINAL BLEND held merely descriptive of cat food).

Regarding the words "engine management," some examples of the Nexis stories submitted by the Examining Attorney are given below (emphasis added):

Electronic **engine management systems**.
These systems, consisting of a computer and sensors, control the engine's ignition and fuel supply. The precision with which they mix the fuel and air and deliver them to the combustion

⁴ The Board hereby takes judicial notice of these two dictionary definitions pursuant to Trademark Rule 2.122(a). See TBMP §712.01 and cases cited therein.

chamber increases engine power and fuel economy while decreasing pollution. The Chicago Tribune, September 28, 1997;

Among the 14 is GM's Delphi automotive Systems group, which will supply **engine management** and brake and suspension **systems**. Ward's Auto World, June 1997;

Recently, Magneti Marelli won contracts to supply **engine management systems** on some Volkswagen Polos and for all the gasoline engines on the Golf IV due next year. Automotive News, July 22, 1996; and

The complete **engine management system** comes from Nippondenso, which already supplies the V12 management system. The electronic control module and several other components were developed exclusively for Jaguar,.... Automotive Industries, June 1996.

Further, the Board also takes judicial notice of the Dictionary of Automotive Engineering (2nd ed.) definition of "engine management system" as "[an] arrangement of microprocessor-controlled electro-mechanical devices for controlling a vehicle engine."

The record before us establishes that "engine management" refers to a specific electronic system which controls parts of a vehicle engine, and it also identifies the category of products which comprise that system or are integral to that system. These engine parts are the very automobile parts featured in applicant's mail order catalog services.

Applicant's argument that "the words 'Engine Management' do not even remotely describe the goods [applicant] provides in connection with its services: catalogs" (brief, p. 3) is not persuasive. Applicant is not seeking registration of the mark for "catalogs." Further, the goods which will be available through applicant's identified services are not "catalogs." Applicant identified its services as "mail order catalog *services featuring automobile parts, namely, engine control components.*" (Emphasis added.) Thus, as identified, applicant intends to offer automobile parts, namely engine control components, for sale through its mail order catalog services. The catalog (consisting of information relating to the location and distribution of engine control components) provides the means for the consumer to order the goods featured in the catalog, including engine management goods. In its reply brief, applicant even concedes that "applicant's services relate to those goods" (reply brief, p. 1). See *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985).

In this context, the term "engine management" clearly refers to the engine management system and/or to the automotive parts which comprise such a system, and consumers would so understand the term. The term

"original" would be understood by consumers as signifying that applicant's engine management parts are "authentic" or "genuine." Thus, the mark ORIGINAL ENGINE MANAGEMENT, when used in connection with applicant's "mail order catalog services featuring automobile parts, namely, engine control components," immediately, and without conjecture or speculation, describes to purchasers a significant, central feature of applicant's services, namely, that the goods offered for sale through its mail order services are genuine or authentic engine management parts.

Applicant's argument that its mark suggests services relating to engine maintenance is unpersuasive because there is no evidence of record to support it. The Examining Attorney submitted sufficient evidence to establish a prima facie showing that applicant's mark is merely descriptive of applicant's identified services.

The Court of Appeals for the Federal Circuit has long recognized that "the practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action." In *re* Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). Once the Office has met its burden of establishing a prima facie case, applicant must do more than merely argue the issue. As stated by the Court of

Appeals for the Federal Circuit in *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987):

Appellant argues that descriptiveness is to be determined by the 'ultimate purchasers and not by those who would have seen the wholesale catalogue,' and that 'there is no evidence at all from the purchasing public.' It is correct that the trademark attribute of descriptiveness vel non is determined from the viewpoint of the purchaser. In *re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986). However, the burden of coming forward with evidence in support of the applicant's argument was upon the applicant. It is insufficient, in view of the PTO's prima facie case, to criticize the absence of additional evidence weighing against the applicant. Rebuttal evidence and argument are the applicant's province.

In this case, applicant's application is based on its assertion of a bona fide intent to use and, thus, there are no specimens of record for our review. Moreover, applicant submitted no evidence in this appeal relating to either its own intended use of its mark or establishing that purchasers would "more likely" perceive the term "engine management" as relating to engine maintenance.

Accordingly, based on the record before us, we find applicant's mark is merely descriptive. When the mark ORIGINAL ENGINE MANAGEMENT is viewed as a whole, in the context of applicant's services, we find that the purchasing public would, without imagination or conjecture,

readily understand the words to mean what applicant's services entail, i.e., the mail order purchase of genuine or authentic automotive parts which are part of an engine management system. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996); *In re Energy Products of Idaho*, 13 USPQ2d 2049 (TTAB 1989); and *In re Truckwriters Inc.*, 219 USPQ 1227 (TTAB 1983), *aff'd* unpubl'd Appeal No. 84-689 (Fed. Cir., November 1, 1984).

Decision: The refusal to register under Section 2(e)(1) is affirmed.

G. D. Hohein

B. A. Chapman

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board